

REMARKS

In the Final Office Action, the Examiner rejected pending claims 1-15 and 21-27. Applicants amended the specification to reproduce text from Hottovy et al. (U.S. Patent No. 6,239,235) which is incorporated by reference in the specification. *See* Specification, paragraph 33. No new matter has been added. Further, Applicants submit the enclosed Rule 131 Declaration and the associated Exhibits A, B, C, D, and E pursuant to 37 C.F.R. § 1.131 to swear behind both Kendrick et al. (US 2002/017358 A1) and Kendrick et al. (US 2003/0161765 A1). Applicants respectfully request reconsideration and allowance of all pending claims.

Rejection under 35 U.S.C. § 112

The Examiner rejected claims 1-15 and 21-23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. *See* Final Office Action, page 2 (asserting that the claims contain subject matter not described in the specification). In particular, the Examiner contended that an element added to claim 1 in the previous Response does not have support in the present application and is new matter. *See* Final Office Action, page 2. This element of claim 1 that the Examiner asserts is new matter reads: “withdrawing a portion of the fluid slurry as an intermediate product at a slurry withdrawal location in the loop reaction zone where the intermediate product contains a higher concentration of the solid polyolefin particles than an average concentration of the solid polyolefin particles the fluid slurry in the loop reaction zone.” *See id.* Applicants respectfully traverse this rejection.

Applicants stress that this element in claim 1 is supported by Hottovy et al. (U.S. Patent No. 6,239,235), a U.S. patent that is incorporated by reference in the present specification (in paragraph 33). *See* 37 C.F.R. § 1.57(c) (explaining that a U.S. patent or U.S. patent application that is incorporated by reference in a later application may be relied upon to satisfy the written description requirement in that later application); specification, paragraph 33. Support for this claim 1 element in question and for claims 1-15 and 21-23 as rejected can be found at column 2, line 60 to column 3, line 39 of the incorporated Hottovy et al. (6,239,235) reference. Therefore, Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. § 112, and allow the claims. Lastly, Applicants note that for clarity, the present specification is amended to reproduce text found at column 2, line 60 to column 3, line 39 of the incorporated Hottovy et al. (6,239,235) reference.

Rejections Under 35 U.S.C. § 102(e)

The Examiner rejected claims 1-15 and 21-27 under 35 U.S.C. § 102(e) as being anticipated by Kendrick et al. (US 2002/0173598 A1) and, alternatively, as being anticipated by Kendrick et al. (US 2003/0161765 A1). Applicants respectfully traverse these rejections.

In view of the earlier date of the invention of the subject matter disclosed and claimed in the present application, however, Applicant elects to remove both Kendrick et al. (US 2002/0173598 A1) and Kendrick et al. (US 2003/0161765 A1) pursuant to 37 C.F.R. § 1.131 (hereinafter “Rule 131”). Under Rule 131, an applicant may overcome a prior art rejection by filing an appropriate declaration that establishes invention of the

claimed subject matter by the applicant prior to the effective date of the reference relied upon in the rejection. Prior invention may be shown either by proving an actual reduction to practice prior to the effective date of the reference, or by proving conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the effective date of the reference to either an actual or constructive reduction to practice. *See* 37 C.F.R. § 1.131(b); M.P.E.P. §715.07(III). “The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice.” M.P.E.P. § 2138.06 (noting that reduction to practice encompasses constructive reduction to practice established by the filing of a U.S. patent application).

In establishing due diligence, an applicant must show that he proceeded with diligence during the critical period toward a reduction to practice, either actual or constructive. *See Haskell v. Colebourne*, 213 U.S.P.Q. 192, 194 (C.C.P.A. 1982) (citing *Boyce v. Anderson*, 171 U.S.P.Q. 792, 793 (9th Cir. 1971)). To satisfy the diligence standard, constant effort is not required, and the inventor and others need not spend all of their time working on the invention. *See, e.g., Mycogen Plant Science, Inc. v. Monsanto Co.*, 58 U.S.P.Q.2d 1891 (Fed Cir. 2001), *reh’g denied*, 59 U.S.P.Q.2d 1852 (Fed. Cir. 2001) (“To be sure, the evidence suggest that there were short gaps in the work that was done . . . during the critical period. Proof of diligence, however, does not require a party to work constantly on the invention or drop all other work.” (citations omitted)).

Furthermore, with respect to the “facts” presented pursuant to 37 C.F.R. § 1.131, the M.P.E.P. states that “when reviewing a 37 C.F.R. 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and ‘notes.’” *See* M.P.E.P. § 715.07(I). Moreover, “an accompanying exhibit need not support all of the claimed limitations but rather a missing feature may be supplied by the declaration itself.” *Ex parte Ovshinsky*, 10 U.S.P.Q.2d 1075, 1077 (PTO Bd. App. 1989) (citing *Ex parte Swaney*, 89 U.S.P.Q. 618 (PTO Bd. App. 1950)). For example, “it is entirely appropriate for [an applicant] to rely on a showing of facts set forth in the Rule 131 declarations themselves to establish conception of the invention prior to the effective date of the reference.” *Id.*

With the foregoing in mind, Applicants respectfully assert that the submitted Rule 131 Declaration and the accompanying exhibits sufficiently establish conception prior to the effective dates of the two cited references and, furthermore, establish diligence during the critical period from just prior to the effective dates of the cited references until constructive reduction to practice of the present application.

Effective Dates of the References

On the face of the documents, the apparent effective dates of the two cited references are their filing dates of February 19, 2002 and February 28, 2002, respectively. The first cited reference, Kendrick et al. (US 2002/0173598 A1), is a continuation-in-part patent (CIP) application. In rejecting the instant claims, the Examiner relied on matter

added to this CIP application at the time of its filing. *See* Final Office Action, pages 2-3. In particular, the material of Kendrick et al. (US 2002/0173598 A1) cited by the Examiner includes claims 161 and 162, paragraphs 26, 27, 64, 56, and 71, and Figs. 5 and 6, all of which were added as new matter to Kendrick et al. (US 2002/0173598 A1) at the time of its filing as a CIP application. *See id.* Therefore, the effective date of the Kendrick et al. (US 2002/0173598 A1) is its filing date of February 19, 2002. The second reference, Kendrick et al. (US 2003/0161765 A1), is a patent application with no priority claim. Therefore, the effective date of Kendrick et al. (US 2003/0161765 A1) is its filing date of February 28, 2002.

Rule 131 Declaration and Associated Exhibits

Applicants respectfully assert that the submitted Rule 131 Declaration and its corresponding exhibits establish: (1) that Applicants conceived the presently claimed subject matter prior to the apparent effective dates the two cited references; and (2) that Applicants were diligent toward actual reduction to practice of the presently claimed subject matter during the critical period. Here, the apparent critical period is from the earlier apparent effective date (February 19, 2002) of the two references to the constructive reduction to practice date (September 13, 2002) of the presently claimed subject matter, i.e., to the filing date of the present application. In the attached Declaration, Applicant Verser states in paragraphs 3 and 4 that he and his co-inventors conceived of the claimed subject matter prior to February 19, 2002, and that work toward actual reduction to practice of the claimed subject matter was diligently performed from

at least as early as February 18, 2002 to September 13, 2002. These statements are corroborated by Exhibits A, B, C, D, and E of the Declaration.

Specifically, Applicants' conception of the claimed subject matter is evidenced by Exhibits A and B attached to the Declaration and which are process flow diagrams dated earlier than February 19, 2002. *See* Rule 131 Declaration of Donald W. Verser, paragraph 3 and Exhibits A and B. As explained in the Declaration, these process flow diagrams illustrate features recited in the instant claims. *See id.* Applicants respectfully submit that Exhibits A and B along with the Rule 131 Declaration are sufficient to demonstrate conception of the claimed subject matter prior to the effective dates of Kendrick et al. (US 2002/0173598 A1) and Kendrick et al. (US 2003/0161765 A1), February 19, 2002 and February 28, 2002, respectively. *See* Rule 131 Declaration of Donald W. Verser, paragraph 3 and Exhibits A and B.

As indicated in paragraph 4 of the Rule 131 Declaration, work toward actual reduction to practice of the subject matter disclosed and claimed was diligently performed from at least as early as February 18, 2002 to September 13, 2002. *See* Rule 131 Declaration of Donald W. Verser, paragraph 4. This work and the diligent performance of this work are evidenced by Exhibits C, D, and E. *See* Rule 131 Declaration of Donald W. Verser, paragraph 4 and Exhibits C, D, and E. Exhibit C includes copies of PowerPoint slides prepared during the critical period between February 18, 2002 and September 13, 2002. *See* Exhibit C. The slides depict actual progress and forecasted progress of activities related to the engineering and construction of a slurry polymerization

process (the 1799 plant) having the features recited in the instant claims. *See* Exhibit C. Further, Exhibit D is a copy of one page from a project report of the 1799 plant, showing the planned and actual durations of activities related to the engineering and construction for the 1799 plant. *See* Exhibit D. Exhibit E is a construction drawing of the 1799 plant prepared prior to February 19, 2002, and showing an embodiment of the claimed subject matter, including a loop reactor having at least one catalyst feed connection, two monomer feeds connections, and at least four continuous takeoff connections. *See* Rule 131 Declaration of Donald W. Verser, paragraph 3 and Exhibit E. As explained in the Declaration, the two monomer feed connections and the four continuous takeoff connections 44 are depicted as being arranged substantially symmetrically. *See id.* Further, the illustrated continuous takeoff connections are positioned on elbows 46 to facilitate withdrawal of an intermediate slurry or product slurry having a solids concentration higher than that of the fluid slurry circulating in the loop reactor during operation. *See id.*

In total, Applicants have demonstrated that the invention disclosed and claimed in the present application was conceived before the effective dates, February 19, 2002 and February 28, 2002, respectively, of the Kendrick et al. (US 2002/0173598 A1) and Kendrick et al. (US 2003/0161765 A1) references. Applicants further demonstrated that work toward actual reduction to practice of the claimed subject matter was diligently performed during the critical period running from prior to the effective of these two cited references to the filing date, September 13, 2002, of the present application. Therefore, Applicants have established an earlier invention date than the apparent effective dates of the Kendrick et al. (US 2002/0173598 A1) and Kendrick et al. (US 2003/0161765 A1


references. Accordingly, Applicant respectfully requests that all rejections based on the Kendrick et al. (US 2002/0173598 A1) and Kendrick et al. (US 2003/0161765 A1 references be withdrawn and that claims 1-15 and 21-27 be allowed.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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